

## REMARKS

This is intended as a full and complete response to the Office Action dated November 22, 2004, having a shortened statutory period for response set to expire on February 22, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Applicant submits herewith a Supplemental Information Disclosure Statement and accompanying Form 1449 listing references for consideration by the Examiner. Applicant respectfully requests that the Examiner consider the references listed in the Form 1449 prior to any further Office Action on the merits of the current application.

The drawings are objected to by the Examiner for failing to show every feature of the invention specified in claims 10-13. Applicant respectfully traverses this objection, as the features recited in claims 10-13 are shown and described in relation to Figures 3-5. Applicant therefore requests removal of the objection to the drawings.

The Examiner states that the Information Disclosure Statement filed on September 24, 2003 fails to comply with 37 CFR 1.98(a)(2). The Examiner states that the "Great Britain Search Report" was not reviewed because each reference cited in the Search Report must be listed separately on the Information Disclosure Statement. Applicant respectfully submits that the three references cited in the Search Report are listed separately as items A3, A4, and A5 on the Form 1449 filed with the aforementioned Information Disclosure Statement, which are all marked as considered by the Examiner in an attachment to the current Office Action. Applicant thus requests consideration of the Great Britain Search Report by the Examiner.

Claims 1-25 are pending in the current application. Claims 1-12 and 14-25 stand rejected, while claim 13 is objected to by the Examiner. Applicant has canceled claims 2, 13, and 14 and amended claims 1, 5, and 15-21. Applicant has added new claims 30-31. Applicant respectfully requests reconsideration of the claims pending in the application for reasons discussed below.

Claims 1-9 and 14-24 stand rejected under 35 U.S.C. § 102(e) as anticipated by *Sivley* (U.S. Patent Number 6,607,220). The Examiner states that *Sivley* discloses an expandable tubular coupling comprising a threaded male portion (designated by number

130) and a corresponding threaded female portion (designated by number 131), the threads being wedge threads limiting the makeup distance of the coupling.

Claims 10-12 and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Sivley*. Regarding claims 10-12, the Examiner states that *Sivley* teaches using a combination of square and dovetail threads, but the Examiner then acknowledges that *Sivley* does not specifically disclose which threads are placed on the leading edge. The Examiner then states that it would have been obvious to one of ordinary skill in the art to place a square profile on the leading edge of the male component and on the trailing edge of the female component because the reversal of components in a prior art reference, where there is no disclosed significance for such a reversal, is a design consideration within the skill of the art. Further, the Examiner states that because the threads increase in width along the length of the threads from the leading edge to the trailing end of the male and female ends, it is inherent that the front male threads with small widths would fit into the wide threads at the leading edge of the female member. Regarding claim 24, the Examiner states that it would have been obvious to make the right hand threads left hand threads because the reversal of components in a prior art reference, where there is no disclosed significance for such a reversal, is a design consideration within the skill of the art.

Applicant respectfully traverses the rejection to claims 1, 3-12, and 15-25. Claim 1 and claims 3-12 and 15-25 dependent therefrom include an expandable tubular coupling having male and female threaded portions, each portion featuring first and second parts with first and second thread profiles, respectively, having different shapes. In contrast, *Sivley* teaches a coupling with male and female thread portions, either all of the threads being dovetail-shaped or instead all of the threads being semi-dovetail-shaped (“wedge” threads are used within *Sivley* as a synonym to “dovetail-shaped” threads). See *Sivley* at e.g., col. 8 Ins. 24-40, and col. 9 Ins. 24-48 and 62-67. The dovetail shape of the threads is used in *Sivley* to provide resistance to radial separation of the connection during expansion and to provide sufficient contact stress at the shoulder. See *id.* at col. 9 Ins. 40-62.

Nowhere within *Sivley* is any mention made of the thread forms within the same coupling being of different shapes. Rather, the disclosure and drawings of *Sivley* only

teach all of the threads being dovetail-shaped or all of the threads being partially dovetail-shaped to prevent the pin member and box member of the threaded connection from deforming radially relative to one another after expansion of the connection.

However, the Examiner uses the statement in *Sivley* at the end of the specification that “embodiments may comprise standard (e.g., API or square) thread forms in combination with aspects described above” to teach the claim element of the first and second threaded portions having first and second thread profiles with different shapes. See *Sivley* at col. 15 Ins. 21-23. No aspect “described above” within *Sivley* teaches, shows, or suggests including thread forms of any different shapes on the same coupling. Furthermore, no aspect “described above” within *Sivley* teaches, show, or suggests including thread forms of any different shape on different parts of the male threaded portion itself or on different parts of the female threaded portion itself, as recited in claim 1 and its dependent claims. Therefore, the statement within *Sivley* that “embodiments may comprise . . . square . . . thread forms in combination with aspects described above” could only include couplings having all square-shaped thread forms on the male and female threaded portions, as no other aspects were described within *Sivley*.

Accordingly, *Sivley* does not teach, show or suggest an expandable tubular coupling comprising a threaded male portion; and a corresponding threaded female portion, the threaded portions featuring thread profiles configured such that the coupling may be made up to a predetermined extent, and once made up to said predetermined extent may be made up no further, each threaded portion comprising a first part having a first thread profile, and a second part having a second thread profile, the first thread profile having a different shape than the second thread profile, as recited in claim 1 and its dependent claims 3-12 and 15-25. Applicant thus respectfully requests removal of the rejection to and allowance of claims 1, 3-12, and 15-25.

New claim 31 depends from claim 1. Therefore, Applicant respectfully submits that claim 31 is allowable over *Sivley* for the same reasons that claim 1 is allowable over the reference, as discussed above. Applicant thus respectfully requests allowance of new claim 31.

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims. Applicant has rewritten claim 13 in substantially the same form as new, independent claim 30; therefore, Applicant respectfully requests allowance of new claim 30.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to Applicant's disclosure than the primary references cited in the Office Action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed. Having addressed all issues set out in the Office Action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests allowance of the claims.

Respectfully submitted,



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